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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/783,930

02/20/2004

Richard Eckhardt

D.1610

7281

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7590

08/21/2007

JOHN E. TOUPAL

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EXAMINER

GATES, ERIC ANDREW

ART UNIT

PAPER NUMBER

3722

MAIL DATE

DELIVERY MODE

08/21/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

7

Office Action Summary

Application No.

10/783,930

Applicant(s)

ECKHARDT, RICHARD

Examiner

Eric A. Gates

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 10-13 and 20 is/are rejected.
- 7) ☒ Claim(s) 7-9 and 14-19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to Applicant's amendment filed 14 December 2006.

Claim Objections

Claims 1-3, 6, 8, 9, 15, 16, and 18 are objected to because of the following informalities:

- a. In claim 1, line 4, "insertion into the one opening" should be changed to "insertion into the one or more openings".
- b. In claims 2, 6, 8, 9, 15, 16, and 18, the phrases "inner end portion" and "outer end portion" should be changed to "inner end pin portions" and "outer end pin portions" to differentiate them from the "outer end clamp portions".
- c. In claim 3, the reference characters "d" and "W" should be placed in parentheses.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 6, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Higgs (4,675,953).

Higgs discloses in Fig. 2-4, a retainer comprising a pin (10) comprising a shank portion (portion connecting of portions 25 and 26); an outer end pin portion (portions of 25/26 not including connected portions between 25 and 26 or attachment point to member 11) having an entirely exposed outer surface, extending longitudinally (upwards and downwards in figure 3) from said shank portion and defining a pair of transversely extending parallel surfaces penetrated by bores (as seen in figures 2-4) with transversely spaced apart axes; an inner end pin portion (portion of 26 attached to member 11), attachable to support mounting member (11); a spring clamp (12) comprising a pair of unparallel (as shown in Fig. 3) leg portions (21 and 22) having the same length and having outer end clamp portions joined by a yoke portion (20) and inner ends each joined to a journal portion (23 and 24) received by a different one of the bores; wherein the outer end pin portion is displaced a substantial distance from the inner end pin portion (see Fig. 2-4); wherein the leg portions (21 and 22) are substantially parallel and the yoke portion (20) is elongated and projects transversely from the leg portions.

In regards to Claim 1, wherein the pin adapted for attachment to a mounting member for supporting a stack of sheets having one or more openings, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the

intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the pin of Higgs is capable of supporting a stack of sheets having openings. Since applicant has not positively claimed a retainer "in combination with a stack of apertured sheets" in detail, the limitations are merely seen as intended use.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 5, 11-13, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Higgs.

Higgs discloses a retainer comprising all the elements as claimed in Claims 1 and 2, and as set forth above. Higgs further discloses wherein the legs are parallel in the y-axis as shown in Fig. 5. However, Higgs does not disclose wherein the distance between the outer end portion and the inner end is greater than the maximum width of the pin; wherein the bores lie in a obtusely oriented plane; wherein the pin is cylindrical; wherein the leg portions are substantially parallel and the yoke portion is elongated and project transversely from the leg portions.

In regards to Claim 3, it would have been obvious to construct the distance between the outer and the inner end in any desirable length distance, since such a

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modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art.

Therefore, it would have been obvious to construct the distance length in any desirable size, since applicant has not disclosed the criticality of having a particular size dimension (distance), and invention would function equally as well in any desirable size dimension.

In regards to Claims 5, 12, and 20, it would have been obvious to place the bores at any desired angled location, since it has been held that rearranging parts of an invention involves only routine skill in the art. Therefore, it would have been obvious to place the bores at any desired location since applicant has not disclosed the criticality of having the bore placement at a particular location, and would function equally as well at any location.

In regards to Claim 13, it would have been to make the pin of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. Therefore, it would have been obvious to make the pin of whatever shape or form as desired, since applicant has not disclosed the criticality of having a particular shape, and invention would function equally as well with any shape.

Allowable Subject Matter

Claims 7-9, 14-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The indicated allowability of claim 20 is withdrawn in view of the change of dependence of claim 20.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric A. Gates whose telephone number is (571) 272-5498. The examiner can normally be reached on Mon-Thurs 8:45 - 6:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on (571) 272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



EAG
20 August 2007



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